

### **Remarks**

The Office Action of April 2, 2010 has been received and reviewed. In this response, claims 1, 11, 13, and 16 have been amended and no claims have been cancelled or added, leaving claims 1-6, 11-13, and 16-22 pending. Reconsideration and withdrawal of the rejections are respectfully requested as discussed herein.

### **Claim Amendments**

Claim 1 has been amended to recite wherein each adapter of the set of adapters is configured to be used separately from one another to electrically connect the single lead connector to the implantable medical device and to make other various changes.

Claims 11 and 13 have been amended to recite wherein each adapter of the first adapter and the second adapter is configured to be used separately from one another to electrically connect the lead connector to the implantable medical device and to make other various changes.

Claim 16 has been amended to recite wherein each adapter of the first adapter and the second adapter is configured to be used separately from one another to electrically connect the lead connector to the medical device and to make other various changes.

These amendments are intended to make explicit what was already implied, e.g., these amendments are not narrowing. Support for these amendments may be found in the application as filed at, e.g., paragraphs [17], [19]-[20], & [22]-[23] and Figures 4-7. Entry and consideration of these amendments are respectfully requested.

### **The 35 U.S.C. §102 Rejections**

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *See* M.P.E.P. §2131.

Claims 1-6, 11-13, and 16-21 were rejected under 35 U.S.C. §102(e) as being anticipated by each of Sommer et al. '900 (U.S. Patent No. 6,705,900), Sommer et al. '295 (U.S. Patent No. 6,921,295), and Stein et al. (U.S. Patent No. 6,854,994). These rejections are respectfully traversed.

Applicants submit that each of Sommer et al. '900, Sommer et al. '295, and Stein et al. fails to describe each and every element as set forth in claims 1-6, 11-13, and 16-21 as required for an anticipation rejection.

Although Applicants believe that the claims prior to the present amendment were patentable over each of Sommer et al. '900, Sommer et al. '295, and Stein et al., independent claims 1, 11, 13, and 16 have been amended herein, e.g., to make explicit what was already implied.

Independent claims 1, 11, 13, and 16 recite, among other things, a first adapter and a second adapter. Independent claim 1 recites that each adapter of the set of adapters is configured to be used separately from one another to electrically connect the single lead connector to the implantable medical device, each of independent claims 11 and 13 recites that each adapter of the first adapter and the second adapter is configured to be used separately from one another to electrically connect the lead connector to the implantable medical device, and independent claim 16 recites that each adapter of the first adapter and the second adapter is configured to be used separately from one another to electrically connect the lead connector to the medical device.

Each of Sommer et al. '900, Sommer et al. '295, and Stein et al. fails to describe each and every element as set forth in claims 1-6, 11-13, and 16-21 as required for an anticipation rejection. For example, nothing has been identified by the Office Action within each of the disclosures of Sommer et al. '900, Sommer et al. '295, and Stein et al. that describes that each adapter of the set of adapters (claim 1)/the first adapter and the second adapter (claims, 11, 13, and 16) is configured to be used separately from one another to electrically connect the lead connector to the medical device as set forth in independent claims 1, 11, 13, and 16.

In the Office Action, the first tubular member 252 of Sommer et al. '900, Sommer et al. '295, and Stein et al. has been equated to the claimed first adapter and the second tubular member 264 of Sommer et al. '900, Sommer et al. '295, and Stein et al. has been equated to the claimed second adapter. As described and shown in each of Sommer et al. '900, Sommer et al. '295, and Stein et al., the tubular members 252, 264 are used together with each other to electrically connect a lead to the medical device. In other words, the tubular members 252, 264 of Sommer

et al. '900, Sommer et al. '295, and Stein et al. are not configured to be used separately from one another to electrically connect the lead connector to the medical device as would be required to anticipate independent claims 1, 11, 13, and 16.

For this reason alone, Applicants respectfully submit that the anticipation rejections of independent claims 1, 11, 13, and 16 (from which claims 2-6, 12, and 17-21) over each of Sommer et al. '900, Sommer et al. '295, and Stein et al. cannot be maintained. Nonetheless, independent claims 1, 11, 13, and 16 recite additional elements that further support patentability over each of Sommer et al. '900, Sommer et al. '295, and Stein et al.

For example, each of independent claims 1, 11, and 13 recites that the one or more conductive portions of the external surface of the first adapter are located in the same location along the external surface thereof as the one or more conductive portions of the external surface of the second adapter and independent claim 16 recites that the external contact element of the first adapter is located along the external surface of the first adapter in the same location as the external contact element of the second adapter. The external conductive portions of each of the first tubular member 252 and second tubular member 264 of each of Sommer et al. '900, Sommer et al. '295, and Stein et al. are not located in the same location along the external surfaces thereof.

For at least these reasons, Applicants submit that each of Sommer et al. '900, Sommer et al. '295, and Stein et al. fails to describe each and every element as set forth in independent claims 1, 11, 13, and 16 as required for an anticipation rejection.

Furthermore, because dependent claims 2-6, 12, and 17-21 are directly or ultimately dependent on independent claims 1, 11, 13, or 16, dependent claims 2-6, 12, and 17-21 are also novel over each of Sommer et al. '900, Sommer et al. '295, and Stein et al. for the same reasons as presented above for independent claims 1, 11, 13, and 16. Moreover, such claims contain recitations that further support patentability.

Reconsideration and withdrawal of these rejections are respectfully requested.

**The 35 U.S.C. §103 Rejection**

Claim 22 was rejected under 35 U.S.C. §103(a) as being unpatentable over Sommer et al. '900 (U.S. Patent No. 6,705,900), Sommer et al. '295 (U.S. Patent No. 6,921,295), or Stein et al. (U.S. Patent No. 6,854,994). This rejection is traversed.

Because claim 22 is directly dependent on independent claim 16, claim 22 is at least, for example, nonobvious over each of Sommer et al. '900, Sommer et al. '295, and Stein et al. for the same reasons as presented herein with respect to the §102 rejections of independent claim 16. Moreover, claim 22 contains recitations that further support patentability.

Reconsideration and withdrawal of this rejection are respectfully requested.

**Double Patenting Rejection**

Claims 1-6, 11-16, and 16-22 were rejected under non-statutory obviousness-type double patenting as being unpatentable over claim 8 of Sommer et al. '900 (U.S. Patent No. 6,705,900). More specifically, it has been asserted in the Office Action that although the conflicting claims are not identical, they are not patentably distinct from each other because both discloses a set of adapters with a first and second adapter that are integrally connected and placed within the bore of a medical device. This rejection is respectfully traversed.

A double patenting rejection of the obviousness-type, if not based on an anticipation rationale, is analogous to a failure to meet the nonobviousness requirement of 35 U.S.C. §103 except that the patent principally underlying the double patenting rejection is not considered prior art. *See* M.P.E.P. § 804(II)(B)(1) (*citing In re Braithwaite*, 379 F.2d 594, 154 U.S.P.Q. 29 (CCPA 1967)). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *See In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1970). Further, the Board of Patent Appeals and Interferences has confirmed that all claim limitations must be taught or suggest by the prior art to establish a case of *prima facie* obviousness:

**Amendment and Response**

Serial No.: 10/646,545

Confirmation No.: 9714

Filed: August 21, 2003

For: MEDICAL LEAD CONNECTOR SYSTEMS WITH ADAPTERS (as amended)

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Page 16 of 17

When determining whether a claim is obvious, an examiner must make 'a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.' *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, 'obviousness requires a suggestion of all limitations in a claim.' *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). *In re Wada*, Appeal 2007-3733, Application 10/613,220, (B.P.A.I. 2008).

Applicants respectfully submit that Sommer et al. '900 (e.g., including claim 8 of Sommer et al. '900) fails to teach or suggest all the claim elements recited in claims 1-6, 11-16, and 16-22 as required for a non-statutory obviousness-type double patenting rejection as presented herein with respect to the §102 rejections.

Reconsideration and withdrawal of this rejection are respectfully requested.

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Page 17 of 17

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**Summary**

It is respectfully submitted that the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives at the telephone number listed below if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted

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**CERTIFICATE UNDER 37 C.F.R. §1.8:**

The undersigned hereby certifies that this paper is being transmitted via the U.S. Patent and Trademark Office electronic filing system in accordance with 37 C.F.R. §1.6(a)(4) to the Patent and Trademark Office addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 29<sup>th</sup> day of July, 2010.

By: 

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